UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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GENENTECH, INC.
1 DNA WAY
SOUTH SAN FRANCISCO, CA 94080

In re Application of	:
James Andya et al	:
Serial No.: 09/705,457	: PETITION DECISION
Filed: November 2, 2000	:
Attorney Docket No.: P0998D3	:

This letter is in response to the petition under 37 CFR 1.181, filed March 6, 2003, requesting withdrawal of finality of an Office action..

BACKGROUND.

An abbreviated file history shows that the examiner mailed a third Office action to applicants on July 10, 2002, setting a three month shortened statutory period for reply. The Office action set forth a single rejection of claims 37-40 and 44 under 35 U.S.C. 103(a) as unpatentable over US 5,965,709 (Presta et al) in view of US 5.580.856 (Prestrelski et al). Prestrelski et al was relied on solely to meet a concentration limitation of "about 50mg/ml to about 400mg/ml". The reference taught an upper limit of "about 20 mg/ml".

Applicants replied to the rejection by amending claim 37 to recite "50mg/ml to about 400 mg/ml", thus avoid the reference teaching. The examiner mailed a Final Office action to applicants on January 13. 2003, setting forth a new rejection of claims 37-40 and 44-45 under 35 U.S.C. 103(a) as unpatentable over US 5,965,709 (Presta et al) in view of US 4,093,606 (Coval). The examiner stated that applicants' amendment necessitated the new ground of rejection.

Applicants petition the finality of the Office action as improper since the Coval reference was cited in an IDS to the examiner prior to first action on the merits and has been of record, but not applied, and that M.P.E.P. 706.07(a) specifically prohibits making an Office action final in this particular situation.

DISCUSSION

A review of the file shows that applicants have properly summarized the file history. The examiner did rely on a reference (Prestrelski et al) teaching a concentration of an antibody of up to "about 20mg/ml" and argued that "about" allowed that limit to be extended sufficiently that applicants' lower limitation of "about 50mg/ml" was taught or suggested. When applicants

amended the claims to make the lower limit a specific amount (50mg/ml) the examiner conceded that the Prestrelski et al reference was insufficient to teach or suggest the narrowed lower limit. Therefor the examiner chose to rely on a new reference teaching an upper limit of 50mg/ml (taught in the reference as 5%) concentration. This reference, Coval, was available to the examiner prior to first Office action and could have been applied in any previous Office action. In view of the "about" terminology used in both applicants' claims and the Prestrelski et al reference and the difference between them (about 20mg/ml vs. about 50mg/ml) a reasonable examiner should have looked for and utilized a secondary reference bridging this gap in an earlier Office action on the basis that it would be a reasonable action on applicants' part to narrow the claim limitation.

DECISION

The petition is **GRANTED.**

The Office action mailed January 13, 2003, is changed to a non-Final Office action. Applicants remain under obligation to respond to the Office action within the time period set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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